

### **REMARKS/ARGUMENTS**

The Examiner has indicated that claims 13 and 16 contain allowable subject matter. Applicant thanks the Examiner for his findings with respect to these claims.

#### **I. Introduction**

Claims 1–27 are pending in the above application.

Claims 1–12, 14–15, and 17–27 stand rejected under 35 U.S.C. §102(b).

Claims 13 and 16 stand objected to as containing allowable subject matter.

#### **II. Amendments**

The applicant has canceled claim 13 and 16 without prejudice or disclaimer. Applicant has introduced a new independent claim 28 that incorporates the subject matter of claim 13. Accordingly, applicant believes that claim 28 and its dependencies (claims 29–34) are in condition for allowance, and no further response is believed necessary. Applicant has also introduced new independent claim 35 that incorporates the subject matter of claim 16. Accordingly, applicant believes that claim 35 and its dependencies (claims 36–46) are in condition for allowance, and no further response is believed necessary.

Applicant has made a minor voluntary amendment to the claim dependency of claim 14 to account for the canceling of claim 13.

#### **III. Rejection Under 35 U.S.C. §102(b)**

Claims 1–12, 14–15, and 17–27 stand rejected under 35 U.S.C. §102(b) as being anticipated by Javahery et al. (U.S. Patent No. 6,093,929). Applicant submits that this rejection is improper since the Javahery et al. reference was improperly cited and therefore the Examiner's communication of February 27, 2004, should be withdrawn.

As applied by the Examiner, anticipation under 35 U.S.C. §102(b) requires that the invention be patented in the U.S. or a foreign country more than one year before the date of the application for patent in the United States. The Javahery et al. reference was patented July 25, 2000. The instant application is a National Phase entry of international application PCT/CA99/001142, which has an international filing date of November 30, 1999. Under 35 U.S.C. §363 an international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e). See, for example Farnum v. Manbeck 21 U.S.P.Q. 2d 1691 (DC 1991); Odone v. Croda International Plc 950 F. Supp. 10 (DC 1997); Group One Ltd. v. Hallmark Cards, Inc. 1999 WL 33457185 (W.D. Mo. 1999).

As the Javahery et al. reference was patented after the international filing date for the instant application; applicant submits that the Examiners rejection is improper and should be withdrawn.

Notwithstanding applicants' submission that the rejection is improper, applicant wishes to make the following comments. The Examiner has rejected claims 1–12, 14–15, and 17–27 as being anticipated by Javahery et al. Anticipation under 35 U.S.C. §102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See C. R. Bard, Inc. v. M3 Sys., Inc., 157 F. 3d 1340, 1349, 48 USPQ 2d (Fed. Cir. 1998); and Connell v. Sear, Roebuck & Co., 220 USPQ 193, 198 (Fed. Cir. 1983).

The Examiner states that Javahery et al. teaches a mass spectrometer device and associated method comprising (1) subjecting an input (Fig. 9 Items 12 and 20) stream of ions to a first mass analysis in quadrupole (Q32) at a pressure no higher than approximately  $2 \times 10^{-5}$  torr to select ions having a mass-to-charge ratio is a first desired range (Col. 7, lines 36–61); (2) passing the selected ions into a radio frequency linear ion trap (Q33) containing a gas (Col. 7, lines 36–Col. 8, line 23); (3) trapping the selected ions in the linear ion trap (Q33) and exciting the trapped ions to cause collisions with the gas and fragmentation (Paragraph 11); (4) subjecting the fragment

ions to a secondary excitation (Q34), different from the first excitation to cause excitation and fragmentation of selected fragment ions; and (5) passing the ions out of the linear ion trap (Q34) and subjecting the ions to a further mass analysis step (Q35) to determine the mass spectrum of the ions, as recited in applicants claims 1 and 17.

Applicant is intimately familiar with the teachings and disclosure of Javahery et al. In Javahery et al., Figure 9, Q32 is a collision cell where precursor ions are fragmented (see Col. 7, line 46). Ions are not subjected to mass analysis in Q32. Furthermore, the pressure in Q32 is 1 to 7 millitorr (see Col 7, line 41). In contrast, the first mass analyzer in the present invention as set forth in independent claims 1 and 17 is at a pressure no higher than  $2 \times 10^{-5}$  torr.

Moreover, Javahery et al. teaches that ions are mass selected in Q33 (see Col. 7, line 48). Q33 is not a linear ion trap as set forth in independent claims 1 and 17 of the present invention.

Since Javahery et al. does not teach that Q33 is a linear ion trap there is no mention in that patent of exciting trapped ions to cause fragmentation. As already mentioned, Javahery et al. teaches that ions are mass selected in Q33. Moreover, paragraph 11 of Javahery et al. does not mention a linear ion trap.

Furthermore, Q34 in Javahery et al., is not a linear ion trap, it is a collision cell (see Col. 7, lines 50–51).

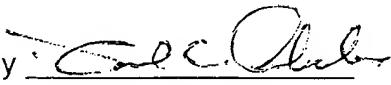
Consequently, Javahery et al. does not describe, either expressly or inherently, the limitations of independent claims 1 and 17, and therefore cannot anticipate claim 1 or claim 17. Claims 2–12, 14–15 depend from claim 1 and include all the limitations of the independent claim. Therefore Javahery et al. cannot anticipate claims 2–12, 14–15. Claims 18–27 depend from claim 17 and include all the limitations of the independent claim. Therefore Javahery et al. cannot anticipate claims 18–27.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Appl. No. 09/857,234  
Amdt. dated May 27, 2004  
Reply to Office action of February 27, 2004

ECKERT SEAMANS CHERIN &  
MELLOTT, LLC

By   
Daniel C. Abeles  
Reg. No. 25,822  
Tel: (412) 566-1295